

IN THE UNITED STATES PATENT OFFICE.

B R U E N I N G

vs.

E D I S O N

Interference No. 18,720

MEMORANDUM FOR EDISON ON HIS MOTION TO DISSOLVE.

This interference involves an application filed by Edison December 3, 1890, and the patent to Bruening No. 462,687 issued November 10, 1891. The invention in controversy relates to the recording and reproducing devices for phonographs.

Edison's Recorder and Reproducer.

Edison in his application discloses three forms of his recording and reproducing device, the feature of each form being a rotating support having two independent diaphragms one provided with a recording point and the other a reproducing point. The support for the recording and reproducing diaphragms is mounted upon an arm adapted to travel on the usual guide-rod, and which arm has the usual forward extension adapted to travel on the front guide-rest. To bring either the recording or reproducing device in operative position, the diaphragm support is rotated on the supporting arm.

Bruening's Recorder and Reproducer.

In the Bruening patent, a single diaphragm is employed, upon the opposite sides of which are located the recording and reproducing points. The diaphragm is carried by a ring, which is adjustably supported by a pivoted arm or frame. The diaphragm ring is described as being adjustable laterally relative to the phonogram blank or phonogram to

adjust the recording or reproducing point relative to the phonogram blank or phonogram. It is stated in the specification of the Bruening patent (page 2, lines 21 to 29 inclusive) that

"In order that the reproducing device may also serve as a reproducer, the style G extends on both sides of the diaphragm x x x so that by reversing the diaphragm the recorder can be changed to a reproducer."

This is the only statement in the Bruening specification relating to the reversal of the diaphragm, and it is not clear from the drawings how this reversal may be accomplished.

The Issue.

The issue is Edison's claim 10 and involves his claim 11, which read as follows :

"The combination with a support mounted to rotate repeatedly in the same direction, of a phonograph recorder on one side thereof and a reproducer on another side."

"The combination with a support movable repeatedly in the same direction, of a recorder thereon at one side and a reproducer thereon on a different side, and means for holding the support in the position to which it is turned, substantially as described."

The claim of the Bruening patent involved in this interference is claim 6, which reads as follows :

"In a phonograph, a reversible diaphragm provided with a style formed on opposite sides with a recording point and a reproducing point, substantially as described."

Edison in his application shows several specific forms of a generic invention, i.e. a combined recording and reproducing device employing two separate diaphragms, one provided with a recording point and the other with a reproducing point, and both carried by a common support adapted to be moved to bring either device into operative position.

Bruening shows another species of the generic invention, i.e. a single diaphragm having a recording point on one side and a reproducing point on the other, the diaphragm being carried by a support intended to be reversed in the holder to bring either point into operative position.

There is no interference in fact between the Edison application and the Bruening patent, for the following reasons:

The Bruening patent does not show or describe or claim the combination of a support mounted to rotate repeatedly in the same direction, a phonograph recorder on one side thereof, and a reproducer on another side. What Bruening does describe and claim is a reversible diaphragm provided with a style which extends on both sides of the diaphragm, one end being formed into a recording point and the opposite end into a reproducing point, so that by reversing the diaphragm either point may be brought into operative position. Such a device is not shown or described or claimed in the Edison application, and there is no reason why an interference should be declared or prosecuted for the purpose of determining priority of invention as to the subject-matter of claim 6 of the Bruening patent. (Reed vs. Landman, C.D. 1891, p. 75.) In that case it was also held that an interference should not be declared between an unexpired patent which shows and claims one species of an invention, and an application disclosing another and different species, even though the latter contains a claim of sufficient scope to include the species claimed in the unexpired patent.

The question of interference in fact between the claims of an unexpired patent containing claims limited to a single species, and an application which shows and describes several species, all different from that claimed in the patent but containing generic claims broad enough to cover the species

of both the patent and the application, was well defined in *Zeitinger vs. Reynolds vs. McIntire*, C.D. 1891, p. 212, wherein it was held that there is no interference in fact between the claims of a patent limited to a single species and the generic claims of an application broad enough to cover the species of both patent and application when the species of the application are all different from the species shown in the patent. The same state of facts are presented in this interference. On the other hand, it was held in that case that an interference in fact does exist between an application showing and describing several species and containing generic claims that cover all of such species, and an unexpired patent containing claims based upon and limited to one of the species covered by the generic claims of the application. This, however, is not the condition of affairs in the present case. As above pointed out, Bruening shows one species, while Edison shows several forms of an entirely different species.

While the claims of the Edison application involved herein are of sufficient scope to cover the recording and reproducing device shown in the Bruening patent, that is no ground for declaring an interference. Thus it was held in *Searle vs. Frumveller vs. Sessions*, C.D. 1892, p. 27, that

"An interference should not necessarily be declared between two applications simply because a claim of one of them would dominate a claim of the other, unless it also appears that the two applications are based upon the same structure of invention."

See also *Van Depoele vs. Daft*, C.D. 1892, p. 15.

Further than this, the claim of the Bruening patent involved herein is specifically limited to a reversible diaphragm provided with a style formed on opposite sides with a

recording point and a reproducing point. Such a construction is not disclosed in the Edison application, and in Dixon vs. Van Auken, C.D. 1893, p. 105, it was held that

"Where the claim in a patent contains an element not disclosed in an application involved in an interference with the patent, and where the applicant cannot make a claim that will be commensurate in terms with the claim of the patent, no interference in fact exists."

In the Edison application, no claim can be made which will be commensurate with the terms of the claim 6 of the Bruening patent. The recording and reproducing points of the Edison devices are entirely independent, and two diaphragms are employed, one for the recording point and the other for the reproducing point, and this construction is the feature of each of the specific forms illustrated and described in the Edison application. Therefore, under the ruling in Dixon vs. Van Auken no interference in fact exists.

Respectfully submitted

Attorneys for Edison.

New York City, September 8, 1897.